

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Valerie Kucharewski et al.	Art Unit :	2145
Serial No. :	10/715,215	Examiner :	Ajay M. Bhatia
Filed :	November 18, 2003	Conf. No. :	2245
Title :	PEOPLE LISTS		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record clearly are not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to expand the identified matters and/or address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-20 are pending with claims 1, 19, and 20 being independent. Applicants understand claims 1-9, 12-16, 19, and 20 to have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,247,043 (Bates), and claims 10, 11, 17, and 18 to have been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of U.S. Patent Application Publication No. 2004/0003071 (Mathew).¹ However, the Advisory Action states that "[c]laims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bates" See Advisory Action of November 15, 2007 at Continuation Sheet. Therefore, in the event that prosecution is not re-opened in response to this pre-appeal brief request for review, applicants request clear articulation from the Office of the grounds for rejection of each of pending claims 1-20 so that applicants have a clear understanding of the rejections for the appeal.

¹ The final Office Action indicates that claims 1-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates. See final Office Action of August 20, 2007 at page 2, lines 14-15. However, applicants note that the final Office Action also indicates that claims 10 and 11 have been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of Mathew and that the grounds of rejection proffered for claims 10, 11, 17, and 18 appear to rely on the combination of Bates and Mathew. See final Office Action of August 20, 2007 at page 8, lines 8-9; page 8, lines 10-19; page 5, lines 4-6; and page 9, line 1 to page 10, line 7. Therefore, applicants understand claims 1-9, 12-16, 19, and 20 to have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates, and claims 10, 11, 17, and 18 to have been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of Mathew.

Applicants traverse the rejection of claims 1-20 and specifically request the panel to review the final Office Action's assertion that Bates anticipates independent claims 1, 19, and 20 because this assertion is based on clear factual error.

DISCUSSION

Independent claim 1 recites a method for enabling management of contacts that includes, among other features, passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member. Because Bates does not describe these features of independent claim 1, the final Office Action makes a clear factual error in asserting that Bates anticipates independent claim 1.

The final Office Action contends that Bates discloses passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member at col. 15, lines 42-57. The assertion that this feature of independent claim 1 is disclosed by Bates at col. 15, lines 42-57 is a clear factual error. When read in the context of its surrounding paragraphs, it is clear that col. 15, lines 42-47 of Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. Rather, this passage from Bates discloses, at most, determining whether a first individual user has exchanged more than a threshold number of communications with a second individual user, and, if so, adding the second individual user to the first individual user's local contacts database:

[The automated addition of entries] is typically performed in response to an accumulation of contacts between a pair of users exceeding a predetermined threshold. . . .

Auto-add entry routine 152 is passed as input the user name being processed by update contact routine 142. . . .

Routine 152 begins in block 180 by determining whether the count field for the entry in the contact table corresponding to the user name passed to the routine exceeds a predetermined

threshold. If it does not, no further processing is required, and the routine 152 terminates. If the count field is greater than the threshold, however, control passes to block 182 to determine whether or not the user name passed to the routine has an entry in the local contact database for the local user. If such an entry already exists, no further processing is required, and routine 152 terminates. However, if no such entry exists, control passes to block 184 to add an entry in the local contact database for the user by copying the corresponding entry from the master contact database. . . .

After an entry is created in the local database, processing is complete, and routine 152 terminates.

The predetermined threshold with which the count field for a user is compared may be set to any number of values to control the frequency at which new entries are added to the local database via routine 152. It will be appreciated that, the higher the threshold, the more contacts are required between any pair of users prior to addition of a new entry to the local contact database. It should be appreciated that, rather than using a composite count, separate counts may be maintained for different contact types, whereby each count type could be compared to a separate threshold, and an entry created if an one count exceeds its corresponding threshold.

Bates at col. 15, lines 5-57 (emphasis added).

As the paragraphs excerpted above clearly reveal, col. 15, lines 42-57 of Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Rather, as is evident by the repeated use of the terms "user name" and "user," this portion of Bates describes determining whether the number of communications exchanged between a first individual user and another individual user exceeds a predetermined threshold, and, if so, adding the second individual user to the first individual user's local contacts database.

Importantly, this portion of Bates does not describe or suggest repeatedly sending communications to a set of contacts as a group, nor does this portion of Bates describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Consequently, the final Office Action's assertion

that the referenced portion of Bates teaches passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member is based on a clear factual error.

The final Office Action's assertion that Bates discloses generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1, also is based on a clear factual error. As discussed above, Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. Moreover, Bates fails to describe or suggest generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1. As such, the final Office Action's assertion that Bates discloses generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1, is based on a clear factual error.

For at least the foregoing reasons, applicants submit that Bates fails to describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, as recited in independent claim 1. Therefore, applicants submit that the final Office Action's assertion that Bates anticipates independent claims 1 is based on clear factual error. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims, claims 2-18.

Independent claims 19 and 20 recite features that are similar to those discussed above in connection with independent claim 1, and do so in the context of an apparatus (claim 19) and a system (claim 20). Therefore, for at least the reasons discussed above in connection with independent claim 1, applicants submit that the final Office Action's assertion that Bates

anticipates independent claims 19 and 20 is based on clear factual error. Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 19 and 20.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 20, 2007


Andrew T. Foy
Reg. No. 57,333

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331